

REMARKS/ARGUMENTS

Petition is hereby made to provisions of 37 CFR 1.136(a) for an extension of three months of the period for response to the Office Action. The prescribed fee is included in the enclosed cheque.

The Examiner made the restriction requirement final. Applicants had elected claims 59 to 74 as directed to hybrid genes comprising PIV-HN and RSV-F. Having regard to the Examiner's position, claims 59 and 70 have been amended to recite the hybrid gene therein and claims 75 and 76 have been deleted as withdrawn from consideration. This amendment is made without prejudice to applicants right to pursue the non-elected claims in divisional or continuation applications.

The Examiner indicated that the IDS filed January 7, 2000 failed to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP 609 on the basis that the Chanock and Prince et al references lack dates of publication and/or pages to be considered. Applicants records show that copies of all the references accompanied the IDS. A further IDS now is enclosed with respect to the Chanock and Prince et al references along with copies of the cited prior art. The enclosed cheque includes the fee for consideration of an IDS at this stage of prosecution.

The Examiner objected to claims 60 and 71 under 37 CFR 1.75(c) as being in improper dependent form for failing to further limit the subject matter of the previous claims. Claims 60 and 71 have been deleted and the dependencies of claims 72 and 73 corrected accordingly.

The Examiner rejected claims 62 and 72 under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Examiner objected to the specification under 35 USC 112, first paragraph, as failing to provide an enabling disclosure without complete evidence that the claimed biological materials and known are readily available to the public or complete evidence of the deposit of biological materials.

In particular, the Examiner indicated that the specification lacks complete deposit information for the plasmid pD2RF-HN (ATCC 75388). As stated in the specification, the deposit of the plasmid was made under the provisions of the

Budapest Treaty on December 17, 1992 (see page 12 of specification). A copy of the deposit forms is enclosed. In addition, it is hereby stated, under the signature of the undersigned, that all restriction on the deposits will be removed upon grant of a patent on this application or precursor application. In the latter respect, it is noted the issuance of US Patent No. 5,968,776. In addition, non-viable deposits will be replaced by the applicant.

Having regard to the above and the enclosure, it is submitted that claims 62 and 72 are no longer open to rejection under 35 USC 112, first paragraph, and the specification is not open to objection under 35 USC 112, first paragraph, with respect to the deposit information. It is submitted the specification fully complies with the provisions of 37 CFR 1.801 to 1.809.

The Examiner rejected claims 59 to 74 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 17 of USP 5,968,776. A rejection of obviousness-type double patenting may be overcome by the submission of a terminal disclaimer. Submitted herewith is a terminal disclaimer, signed by an attorney of record, with respect to the term of this patent which may extend beyond the term of USP 5,968,776. The enclosed cheque includes the prescribed fee for recordal of the Terminal Disclaimer.

Having regard to the Terminal Disclaimer, it is submitted that claims 59 to 74 are no longer open to rejection under the judicially created doctrine of obviousness-type double patenting with respect to claims 1 to 17 of USP 5,968,776.

The Examiner rejected claims 59 to 74 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 20 of US Patent No. 6,225,091. A rejection of obviousness-type double patenting may be overcome by the submission of a Terminal Disclaimer. Submitted herewith is a Terminal Disclaimer, signed by an attorney of record, with respect to the term of this patent which may extend beyond the term of USP 6,225,091. The enclosed cheque includes prescribed fee for recordal of this further Terminal Disclaimer.

Having regard to this Terminal Disclaimer, it is submitted that claims 59 to 74 are no longer open to rejection under the judicially created doctrine of obviousness-type double patenting with respect to claims 1 to 21 of USP 6,225,091.

The Examiner objected to claim 65 under 37 CFR 1.75 as being a substantial duplicate of claim 61. It is submitted that claim 65 is not a substantial duplicate of claim 61. Claim 61 defines a multimeric hybrid gene while claim 65 defines a vector containing the gene. It is submitted, therefore, that claim 65 is not open to objection under 37 CFR 1.75.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned **"Version with markings to show changes made."**

It is believed that this application is now in condition for allowance and early and favourable consideration and allowance are respectfully solicited.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Cancel claims 60, 71, 75 and 76

Claims 59, 62, 72 and 73 have been amended as follows:

59. A multimeric hybrid gene encoding a chimeric protein including a protein from parainfluenza virus (PIV) and a protein from respiratory syncytial virus (RSV), comprising a nucleotide sequence encoding [a PIV-3 protein or a fragment thereof having fusion activity or] a PIV-3 HN protein or a fragment thereof having hemagglutinin-neurominidase activity linked to a nucleotide sequence coding for [a RSV G protein or a fragment thereof having attachment activity or] a RSV F protein or a fragment thereof having fusion activity.

62. The hybrid gene of claim 61 in the form of a plasmid which is [selected from the group consisting of pAC DR7 (ATCC 75389),] pD2 RF-HN (ATCC 75389) [and pD2 F-G (ATCC 75389)].

72. The process of claim 70 [71] wherein said multimeric hybrid gene is contained in an expression vector which is [comprising a gene selected from the group consisting of pAC DR7 (ATCC 75387),] pD2 RF-HN (ATCC 75388) [and pD2 F-G (ATCC 75389)].

73. The process of claim 70 [71] wherein said cellular expression system is provided by mammalian cells, insect cells, yeast cells or fungal cells.